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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

TAN-296

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/078,402

Filed

February 21, 2002

First Named Inventor

NAKADE et al.

Art Unit

1615

Examiner

Blessing Fubara

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 46,376

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

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Typed or printed name

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Telephone number

7-2205

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney's Docket No. TAN-296  
MAIL STOP AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ) Group Art Unit: 1615  
NAKADE; KAMEYAMA )  
Serial No.: 10/078,402 )  
Filed: February 21, 2002 )  
For: METAL OXIDE-ORGANOPOLYSILOXANE HYBRID POWDER AND A  
METHOD FOR THE PREPARATION THEREOF AND A COSMETIC  
COMPOSITION THEREWITH

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents  
Alexandria, VA 22314-1450

Sir:

Further to a Request for Reconsideration filed on June 30, 2005, and subsequent to the Advisory Action of July 18, 2005, Applicants file this Request for a pre-appeal brief conference as set forth in the July 12, 2005, issue of the Official Gazette (Volume 1296, Number 2).

A Notice of Appeal with the appropriate fee is submitted herewith within the three month due date as measured from the Final Office Action of April 22, 2005. Accordingly, this request is timely filed.

REQUEST FOR WITHDRAWAL OF REJECTIONS

Applicants submit this request because the Examiner failed to meet each and every one of the *prima facie* elements for the art rejections under § 102(b) and § 103(a) as well as the rejection

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under § 112, ¶ 1. The Examiner also failed to properly respond to all of Applicants arguments made in the Request for Reconsideration of June 20, 2005, particularly with regard to the rejection under § 112, ¶ 1. The Examiner also incorrectly states that the term "homogeneous" was not discussed during the in-person Interview of May 17, 2005, despite the term being very clearly mentioned in the Interview Summary. See Advisory Action at point 13 and Interview Summary at page 3. The following arguments are based upon clear legal and factual deficiencies in the rejections and do not concern any interpretation of the claims or prior art teachings.

#### PRESENTLY PENDING CLAIMS

Claims 1-3, 5-7, 9-11, 14 and 16-17 are presently pending with an after final amendment entered wherein claims 1-3, 5-7, 9-11, 14 and 16 were amended to recite that the hybrid particles are "homogeneous". See Request for Reconsideration of June 30, 2005 and Advisory Action at point 7.

THE EXAMINER'S REJECTION OF CLAIMS 1-3, 5-7, 9-11, 14 AND 16-17 UNDER 35 U.S.C. § 112, ¶ 1 AS FAILING TO COMPLY WITH THE WRITTEN DESCRIPTION REQUIREMENT IS IMPROPER BECAUSE THE ORIGINALLY FILED SPECIFICATION EXPRESSLY TEACHES A "PARTICLE".

1. The rejection incorrectly states that the original specification does not contain "metal oxide-organopolysiloxane hybrid particles". See Final Office Action of April 22, 2005, at page 2, ¶ 2.

2. However, the specification expressly teaches "particles"

in the specification at page 6, line 19. See Request for Reconsideration at page 8, lines 18-21.

3. The Advisory Action failed to respond to these arguments as properly made in the Request for Reconsideration of June 30, 2005. See Advisory Action at point 13 and Request for Reconsideration at pages 6-9.

THE EXAMINER'S REJECTION OF CLAIMS 1-2, 5, 14 AND 16 UNDER 35 U.S.C. § 102(e) AS BEING ANTICIPATED BY U.S. PATENT NO. 6,200,580 ("HORINO *et al.*") IS IMPROPER BECAUSE THE REFERENCE FAILS TO TEACH EACH AND EVERY CLAIMED LIMITATION.

1. Applicants clearly showed that Horino *et al.* fails to teach homogeneous particles and instead relates to a completely different structure wherein a base material is **surface treated**. See Response of December 27, 2004 at page 4 at line 15; page 5 at lines 16-18; and page 8 at lines 1-12 and Request for Reconsideration at page 10-11 and 13-16; See also Horino *et al.* at col. 13, line 10 and line 18.

3. The particles of the powder of the present invention are a metal oxide-organopolysiloxane **homogenous** hybrid having a totally different structure from that of Horino *et al.* See Response of December 27, 2004 at page 4 at lines 16-19; page 5 at lines 9-13; and page 8 at lines 1-12 and Request for Reconsideration at page 10-11 and 13-16.

4. Applicants submitted a § 1.132 Declaration containing new re-labeled Fig.'s clearly corresponding the prior art particle with the claimed particle. See § 1.132 Declaration of June 30, 2005, at

¶ 5 and 6.

5. The Examiner confuses the requirement for showing experimental evidence in a § 1.132 Declaration to overcome an allegation of non-obviousness with Applicants' submission of Fig.'s that correspond the prior art particles to the claimed particles. See Advisory Action at point 13 and Request for Reconsideration at page 10, lines 8-15.

THE EXAMINER'S REJECTION OF CLAIMS 1-3, 5-7, 9-10 AND 14 UNDER 35 U.S.C. § 102(b) AS BEING ANTICIPATED BY U.S. PATENT NO. 5,843,525 ("SHIBASAKI et al.") IS IMPROPER BECAUSE EACH AND EVERY CLAIMED LIMITATION IS NOT TAUGHT.

1. Applicants clearly showed that Shibasaki et al. fails to teach homogeneous particles and instead relates to a completely different structure wherein a base material is **surface treated**. See Response of December 27, 2004 at page 11 at lines 6-15; page 14 a line 18 to page 15, line 5 and Request for Reconsideration at pages 17-18 and 20-23. See also Shibasaki et al. at Abstract.

3. The particles of the powder of the present invention are a metal oxide-organopolysiloxane **homogenous** hybrid having a totally different structure from that of Shibasaki et al. See Response of December 27, 2004 at page 11 at lines 16-19; page 14 at lines 9-18 and Request for Reconsideration at pages 17-18 and 20-23.

4. Applicants submitted in a § 1.132 Declaration re-labeled Fig.'s clearly corresponding the prior art particle with the claimed particle. See § 1.132 Declaration of June 30, 2005, at ¶ 7 and 8.

5. The Examiner confuses the requirement for showing experimental evidence in a § 1.132 Declaration to overcome an allegation of non-obviousness with the submitted Fig.'s corresponding the prior art particles to the claimed particles. See Advisory Action at point 13 and Request for Reconsideration at page 17, lines 7-15.

THE EXAMINER'S REJECTION OF CLAIMS 3, 10-11 AND 17 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER U.S. PATENT NO. 6,200,580 ("HORINO *et al.*") IS IMPROPER BECAUSE EACH AND EVERY ELEMENT HAS NOT BEEN TAUGHT.

1. Applicants clearly showed that Horino *et al.* fails to teach homogeneous particles and instead relates to a completely different structure wherein a base material is **surface treated**. See Request for Reconsideration at page 24-25 and 27-30; See also Horino *et al.* at col. 13, line 10 and line 18.

2. The particles of the powder of the present invention are a metal oxide-organopolysiloxane **homogenous** hybrid having a totally different structure from that of Horino *et al.* See Request for Reconsideration at page 24-25 and 27-30.

4. Applicants have provided schematic Fig.'s in a § 1.132 Declaration showing new re-labeled Fig.'s clearly corresponding the prior art particle with the claimed particle. See § 1.132 Declaration of June 30, 2005, at page 7.